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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

LIN, KELVIN Y

ART UNIT

PAPER NUMBER

2142

DATE MAILED: 08/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/976,626

Applicant(s)

HAINES ET AL.

Examiner

Kelvin Lin

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/8/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Detailed Action

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 8-13 rejected under 35 U.S.C. 101 because the language of each claim raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.
3. In Claim 8-13, the language "carrier wave" is incapable of being touched or perceived absent the tangible medium therefore, it is not limited to tangible embodiments. In view of Applicant's disclosure, specification pages 2-6, "a computer instruction signal embodied in a carrier wave carrying instruction" is not limited to tangible embodiments. As such, claims 8-13 are not limited to statutory subject matter and is therefore non-statutory. One skilled in the art clearly would not know how to use the claimed invention. Therefore, it is impossible for the specification to teach how to use the invention.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 27-35 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

6. Regarding claims 27-35, the language of "a first side of a firewall" and "the second side of a firewall" have never been defined in the specification. In the specification, page 4-9, the firewall only mentioned by the name and security measure ambiguously, and lack of the procedures work with the hard copy output engine, also the interaction between the first side of firewall and the second side of firewall. Therefore, it is impossible to make and/or use the invention to perform the function of the first and second side of the firewall.

Response to Arguments

Application's argue with respect to claims 1-35 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-35 are rejected under 35 U.S.C 103(a) as being unpatentable over Moshir et al., (US PG Pub No. 20020100036) in view of Lomas et al., (US Pat. No. 6424424).
2. Regarding claim 1, Moshir teaches a method of configuring a hard copy output engine comprising:
 - receiving an electronic message including hard copy output engine configuration data from an undesignated website through a firewall (Moshir, [0021]-[0022], [0031], I.1-8, [0081], I.1-12, [0124], I.1-2, I.6-17, in which the printer connect to the computer and give a recipe, also the configuration including the hardware and software corresponds to the message including the output hardware configuration from any website through a firewall);

Although Moshir at the above mentioned prior art teaches the message including the hardware configuration data, Moshir fails to teach configuring the hard copy engine using the configuration data.

However, Lomas teaches the

- configuring the hard copy output engine using the configuration data (Lomas, col.2, l.20-22).

Furthermore, Lomas teaches a printer access procedure (configuration) for printers over a network via email (Lomas, col.3, l.17-35).

Therefore, It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Moshir's hardware and software installation through network and has been guarded by firewall. The motivation would be for a network installation through network and firewall (Moshir, [0046], l.1-12) to apply to the printer configuration be incorporated easily as taught by Lemos.

3. Regarding claim 2, Lomas further discloses the method of claim 1, wherein receiving the electronic message comprises receiving an email at the hard copy output engine and wherein configuring comprises configuring the hard copy output engine via an embedded web server contained in the hard copy output engine using the configuration data (Lomas, col.3, l.17-35, Fig. 1, in which client processor corresponds to the hard copy output engine).
4. Regarding claim 3, Lomas further discloses the method of claim 1, wherein receiving the electronic message comprises receiving an email (Lomas, col.3, l.14-16).
5. Regarding claim 3, Moshir further discloses the method of claim 1, wherein

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receiving the electronic message comprises receiving an email.

(Moshir, [0021], I. 3-4, I.11-15).

6. Regarding claim 4, Moshir further discloses the method of claim 1, wherein

receiving the electronic message comprises:

- receiving an email through the firewall at a first user station (Moshir, [0052], I.3-5); and
- forwarding the email to the hard copy output engine (Moshir, [0052], I.12-14).

7. Regarding claim 5, Moshir further discloses the method of claim 1, wherein

receiving the electronic message comprises receiving an XML script and

configuring includes setting a threshold for an element chosen from a group

consisting of: pigmentation material, marking material, number of hours of

operation and number of sheets of print media consumed (Moshir, [0086] I.8-12,

inventories means many things like others such as, toner, marking material,

hours of operation, and no. of sheets, and something used by statistics [like

[0081], I.10, [0087], I.7.)

8. Regarding claim 6, Moshir further discloses the method of claim 1, wherein

the hard copy output engine is chosen from a group consisting of: facsimile

machines, photocopiers and printers (Moshir, [0049], I.1-3).

9. Regarding claim 7, Moshir further discloses the method of claim 1, wherein the

configuration data include data prepared by: determining a make and model for

the hard copy output engine; determining a serial number for the hard copy

output engine; and determining user thresholds for consumables associated with the hard copy output engine (Moshir, [0024], I. 1-6).

10. Regarding claims 8-13 claiming for computer instruction signal (Lomas, col. 3, I.50-60) have similar limitations as claims 1-6. Therefore, Claims 8-13 are rejected for the same reasons set forth in the rejection of claims 1-6.
11. Regarding claims 14-20 claiming for the system have similar limitations as claims 1-6. Therefore, Claims 14-20 are rejected for the same reasons set forth in the rejection of claims 1-6.
12. Regarding claims 21-26 have similar limitations as claims 1-6 and plus the limitation of documentation, which Lomas further discloses in (Lomas, col.4, I.21-27). Therefore, Claims 21-26 are rejected for the same reasons set forth in the rejection of claims 1-6.
13. Regarding claim 27, Lomas teaches a method of configuring a method comprising:
 - forming hard copy output engine configuration data on a first side of a firewall based upon input received from a second side of the firewall (Lomas, col.2, I.17-20, I.38-46, in which the printer server and the host processor to perform network related identifier function which corresponds to the undersigned website through a firewall; and

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- transmitting an electronic message including the configuration data through the firewall to a hard copy output engine on the second side of the firewall (Lomas, col.3, l.11-16).

14. Regarding claims 28-35 claiming for the firewall have similar limitations as claims 1-7. Therefore, Claims 28-35 are rejected for the same reasons set forth in the rejection of claims 1-7.

Conclusion

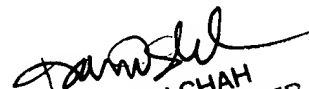
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kelvin Lin whose telephone number is 571-272-3898.

The examiner can normally be reached on Flexible 4/9/5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on 571-272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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KYL


KAMINI SHAH
PRIMARY EXAMINER